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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91216907
Party	Defendant Anastasia Beverly Hills, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BENEFIT COSMETICS LLC,

Opposer,

v.

ANASTASIA BEVERLY HILLS, INC.,

Applicant.

Opposition No. 91216907

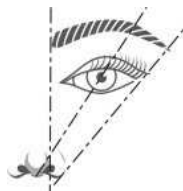
ANASTASIA BEVERLY HILLS, INC.’S
MOTION FOR JUDGMENT ON THE PLEADINGS

Applicant Anastasia Beverly Hills, Inc. (“ABH”) moves the Board for judgment in its favor dismissing Opposition No. 91216907. This motion is made pursuant to Fed. R. Civ. P. 12(c) and TBMP Rule 504 based on the pleadings and facts of which the Board should take judicial notice.

MEMORANDUM IN SUPPORT OF
ABH’S MOTION FOR JUDGMENT ON THE PLEADINGS

I. Introduction

On December 23, 2013, ABH filed use-based applications for the Golden Ratio logo (the “Logo”), which is shown below, for stencils for use in applying makeup and shaping the eyebrow in International Class 16 and tweezers in International Class 8. These applications (the “Applications”) were assigned Trademark Application Serial Nos. 86/150,767 and 86/150,772 respectively.



On June 17, 2014, Opposer Benefit Cosmetics LLC (“Benefit”) filed a consolidated notice of opposition against the Applications. Benefit alleged three grounds for its opposition: (1) functionality; (2) descriptiveness; and (3) failure to function as a trademark. On July 28, 2014, ABH filed its answer.

The parties conducted a discovery conference on August 29, 2014. A few hours later, Benefit propounded 35 interrogatories and 55 document requests. The parties also exchanged initial disclosures.

The purpose of a dispositive motion such as a motion for judgment on the pleadings is to prevent Benefit’s meritless harassment of its competitor, ABH, through the trademark opposition and discovery process. Based on its notice of opposition, Benefit cannot prevail on its claims of functionality, descriptiveness, and failure to function as a trademark as a matter of law.

Therefore, ABH respectfully requests that the Board dismiss Benefit’s opposition with prejudice.

II. Applicable Legal Standard

A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice. *See The Scotch Whisky Assoc. v. United States Distilled Products Co.*, 13 USPQ2d 1711, 1713 n.1 (TTAB 1989). If there are well-pleaded factual allegations that are disputed, the Board may still enter judgment on the pleadings if the Board assumes these disputed facts to be true, draws favorable inferences from the facts, and determines these facts are not material to the outcome of the case. *See Baroid Drilling Fluids, Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1049 (TTAB 1992). In other words, irrelevant or non-material facts, even if true, do not prevent the Board from dismissing *inter partes* proceeding based solely on the pleadings.

It is well established that a motion for judgment on the pleadings can be a basis to dismiss a groundless opposition or cancellation proceeding. *See Media Online Inc. v. El*

Clasificado, Inc., 88 USPQ2d 1285 (TTAB 2008) (likelihood of confusion); *Ava Enterprises, Inc. v. P.A.C. Trading Group, Inc.*, 86 USPQ2d 1659 (TTAB 2008) (likelihood of confusion); *Kraft Group LLC v. William A. Harpole*, 90 USPQ2d 1837 (TTAB 2009) (voidness of application). Accordingly, ABH requests that the Board dismiss this meritless and futile opposition in its infancy before a dilatory and costly discovery period.

III. Argument

A. Benefit's functionality claim

ABH seeks to register a two-dimensional logo. Meanwhile, the functionality doctrine applies to trade dress, which includes “the design of a product (i.e., the product shape or configuration), the packaging in which a product is sold (i.e., the ‘dressing’ of a product), the color of a product or of the packaging in which a product is sold, and the flavor of a product.” TMEP § 1202.2; *Duramax Marine, LLC v. R.W. Fernstrum & Co.*, 80 USPQ2d 1780, 1793 (TTAB 2006) (“The vast majority of the functionality cases deal with product design or product packaging”). As a matter of law, logos are not trade dress. *See Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1067 (2000) (“[t]he breadth of the definition of marks registrable under Section 2, and of the confusion-producing elements recited as actionable by Section 43(a), has been held to embrace not just word marks, such as ‘Nike,’ and symbol marks, such as Nike’s ‘swoosh’ symbol, but also ‘trade dress’—a category that originally included only the packaging, or ‘dressing,’ of a product, but in recent years has been expanded by many Courts of Appeals to encompass the design of a product”).

The functionality doctrine applies to trade dress.

The U.S. Supreme Court has considered the trademark functionality doctrine in several cases. In *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, the U.S. Supreme Court considered whether the coloring of pill capsules was functional. 456 U.S. 844, 857, 214 USPQ

1, 7 n. 20 (holding that the Court of Appeals erred by disregarding the district court’s finding of functionality). In *Qualitex Co. v. Jacobson Products Co., Inc.*, the U.S. Supreme Court considered whether the green-gold coloring of dry-cleaning pads was functional. 514 U.S. 159, 34 USPQ2d 1161, 1164 (1995) (holding that the green-gold color was not functional). In *Wal-Mart*, the U.S. Supreme Court considered whether a clothing design was functional. 54 USPQ2d at 1068 (holding that a product design is distinctive only upon a showing of secondary meaning). And in *Traffix Devices, Inc. v. Marketing Displays, Inc.*, the U.S. Supreme Court considered whether the dual-spring design of road signs and outside signs was functional. 532 U.S. 23, 58 USPQ2d 1001, 1007 (2001) (holding that the trademark infringement plaintiff failed to overcome the inference that its product design trade dress was functional).

Likewise, the Board has considered the functionality doctrine in numerous *inter partes* and *ex parte* proceedings. For example, in *In re Florists’ Transworld Delivery, Inc.*, the Board considered whether the color black, when applied to packaging for flowers, was aesthetically functional. 106 USPQ2d 1784 (TTAB 2013). In *In re Mars Inc.*, the Board considered whether a packaging configuration consisting of a cylindrical, inverted container with a “rounded top” was functional. 105 USPQ2d 1859 (TTAB 2013). And in *In re Charles N. Van Valkenburgh*, the Board considered whether a product configuration for a motorcycle stand was functional. 97 USPQ2d 1757 (TTAB 2011).

The U.S. Supreme Court and Board decisions demonstrate that functionality should be considered in the context of product design and product packaging. These decisions are the basis of the trademark examining guidelines in the Trademark Manual of Examining Procedure. As a result, presumably all trade dress is examined for functionality.

The functionality doctrine does not apply to logos, unless they are product pictures.

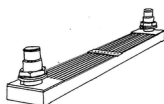
In *Fotomat Corporation v. Photo Drive-Thru, Inc.*, the plaintiff moved for a preliminary injunction preventing the defendant's use of a logo confusingly similar to plaintiff's logo, which was federally registered for use in connection with retail drive-in photographic supply store services:



193 USPQ 342, 348 (D.N.J. 1977). The plaintiff also moved for a preliminary injunction preventing the defendant's use of an overall building design that was similar in appearance to plaintiff's building design. *Id.*

The district court held that the overall building design was functional, but did not use a functionality analysis for the two-dimensional logo *of the building*, drawing a sharp distinction between logos and trade dress. *Id.* at 349-50. The district court explained: "The Court's hesitation to adopt this view [that the building design is protectable] stems in part from the difference between the two-dimensional service mark as registered and the three-dimensional structure as utilized for the functional purpose of retailing, notwithstanding the resemblance between the registered mark and the actual constructed building." *Id.* at 355. The district court also stated: "The finding of infringement of Fotomat's service mark by defendant's logo cannot automatically imply that Fotomat's building design (an extension of the registered service mark) has been infringed by defendant's kiosk. Such an extension without inquiry would overlook the significant differences in purpose between the symbol and the kiosk which may justify a different application of trademark principles." *Id.* at 355 n. 10.

The Board addressed a similar issue in *Duramax*. In that proceeding, the applicant sought to register a logo in International Class 40 for manufacture of marine heat exchangers to the order and specification of others:



80 USPQ2d at 1782. The opposer alleged, *inter alia*, that the applied-for logo “is a picture of a functional and utilitarian product . . . and is . . . equivalent to the utilitarian shape itself.” *Id.* at 1782-83. The Board, rejecting opposer’s functionality argument, stated “there is a significant difference between an application to register trade dress in the nature of product design as a mark for the product itself (e.g., applicant’s abandoned configuration application) and an application to register a two-dimensional drawing that may look very much like such a product, but is used on labels, catalogs, brochures, and in various other ways as a mark for services.”¹ *Id.* at 1793.

In a very limited number of cases, the Board held that a product picture is equivalent to the utilitarian shape of the product. *See, e.g., In re Capri Macaroni Corp.*, 173 USPQ 630, 631-32 (TTAB 1972) (holding that the picture of colored macaroni was not registrable for vegetable macaroni). But this very narrow line of fact-specific cases does not extend to logos in general.

That the *Fotomat* and *Duramax* decisions were in the context of services is not particularly relevant to the distinctions made in both cases between product design and logos. The crux of *Fotomat* and *Duramax* is that a functionality analysis has no place in the examination of logos.

¹ Although, under the facts of the proceeding, the Board refers “services,” the implication of the Board’s statement is that the configuration of a product is distinct from the product and product packaging as well.

The trademark functionality doctrine does not apply to the Logo.

There is no authority for Benefit's allegations that the functionality doctrine applies to the Logo. *See, e.g., Duramax*, 80 USPQ2d at 1793 ("there is no reported case law . . . involving a two-dimensional mark, not trade dress, and involving services, wherein the mark was held not a mark but, rather, functional"). In fact, the trademark functionality doctrine does not apply to the Logo any more than the prohibition against registering portraits of deceased presidents.

The purpose of the functionality doctrine is to prohibit registration of functional product features. ABH is not seeking to register a product feature, and ABH's registration of the Logo does not affect anyone else's manufacturing of tweezers or eyebrow and makeup stencils. As a result, Benefit's functionality allegations are the proverbial square peg in a round hole, and are futile as a matter of law. Any conclusion to the contrary would completely rewrite functionality jurisprudence and require and overhaul of the trademark examining process.

Benefit's allegations regarding the use of brow-mapping diagrams are not relevant to ABH's Applications.

Benefit's notice of opposition alleges that brow-mapping diagrams are used to train cosmetologists and estheticians how to map and shape eyebrows, and that they are used to perform various cosmetology services. *See* Complaint at ¶¶ 7, 8, 13, 14, 15, 20. Likewise, Benefit's notice of opposition alleges that ABH promotes the advantages of its "Golden Ratio" technique. *See* Complaint at ¶ 24.

The issue of functionality must be determined on the basis of the goods set forth in the Applications.² *See Valu Engineering, Inc. v. Rexnord Corp.*, 61 USPQ2d 1422, 1428 (Fed. Cir. 2002); *Duramax*, 80 USPQ2d at 1972 ("[T]hough opposer would have us ignore the identification of services in applicant's application, and essentially treat it as an application to

² Under Trademark Rule 2.122(b), the Applications are already of record in this proceeding.

register a trademark for goods rather than a service mark for services, we find no basis for doing so”). The allegations related to the use of brow-mapping diagrams to perform *services* are not material to whether the Logo is functional for *goods*. The Applications do not cover International Class 44 cosmetology *services* or any other technique- or method-related services.

Similarly, the allegations related to the Golden Ratio technique are not material to these proceedings. Just as the federal registration of the word mark GOLDEN RATIO³ for goods does not affect the ability of third parties to use a certain method or technique of brow mapping (unlike a patent, which could), neither does the registration of a fanciful logo for the same goods.

Benefit’s patent allegations are not relevant to ABH’s Applications.

Benefit’s notice of opposition also alleges that ABH owns three patents and two pending patent applications for products and methods relating to brow shaping. *See* Complaint at ¶¶ 18, 19, 20. But these allegations do not clearly articulate the relationship between the patents and the Logo, and therefore fail to support a claim of functionality.

Common ownership of a patent registration and trademark application does not prevent the registration of the latter. Many patented items are sold using trademarks. This is a common fact of which the Board can take judicial notice.

“It is important to read the patent to determine whether the patent actually claims the features presented in the proposed mark . . . If it does not, or if the features are referenced in the patent, but only as arbitrary or incidental features, then the probative value of the patent as evidence of functionality is substantially diminished or negated entirely.” TMEP § 1202.02(a)(V)(A); *see also TrafFix*, 58 USPQ2d at 1005 (if trade dress protection is sought for

³ ABH owns U.S. Reg. No. 3,949,091 for the word mark GOLDEN RATIO in International Class 8 for tweezers and International Class 21 for stencils for use in applying makeup and shaping the eyebrow.

the features claimed in a utility patent, the utility patent is strong evidence that the trade dress is functional).

For the functionality doctrine to apply to the Applications, ABH would have to be seeking (1) trade dress protection for (2) features claimed in the alleged patent. ABH is not seeking trade dress protection. And ABH is not seeking protection for any features claimed in its patent registrations and applications; the repurposing of a small portion of one patent drawing as a logo is not related to any of the claims in the corresponding patent application. Therefore, the probative value of the patents as evidence of functionality is negated entirely.

B. Benefit's descriptiveness claim

Benefit alleges that the Logo is merely descriptive for “Applicant’s method for mapping eyebrows.” Complaint at ¶ 29. But ABH applied to register the Logo for tweezers and eyebrow and makeup stencils. Even if the Logo is merely descriptive for ABH’s eyebrow-mapping *method*, which it is not, this legal conclusion is not material to the registration of the Logo for other goods and services. *See* TMEP § 1209.01(b) (“The determination of whether a mark is merely descriptive must be made in relation to the goods or services for which registration is sought, not in the abstract”), *citing In re Omaha Nat’l Corp.*, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Dev. Corp.*, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Assocs.*, 226 USPQ 285 (TTAB 1985).

Furthermore, the Logo is not an illustration of tweezers or eyebrow and makeup stencils nor an important feature or characteristic of tweezers or eyebrow and makeup stencils. *See* TMEP § 1209.03(f) (“A visual representation that consists merely of an illustration of the goods, or of an article that is an important feature or characteristic of the goods or services, is merely descriptive under §2(e)(1) of the Act”). Therefore, as a matter of law, the Logo does not describe tweezers or eyebrow and makeup stencils, much less *merely* describe these goods.

Even if the facts alleged in the notice of opposition are true, Benefit cannot prevail on its claim that the Logo is unregistrable under Lanham Act Section 2(e)(1). Therefore, this claim is futile and should be dismissed.

C. Benefit's failure-to-function claim

Benefit alleges that “[t]he diagram that composes Applicant’s Proposed Mark is merely informational in nature, does not uniquely identify Applicant’s goods or services, and is incapable of serving any source-identifying function.” Complaint at ¶ 29.

TMEP Section 1202.04 states: “[s]logans and other terms that are considered to be merely informational in nature, or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry, are not registrable.” Notably, the Logo is neither a slogan nor a term. Likewise, the Logo does not contain or provide any information about tweezers or eyebrow and makeup stencils. As a result, the Logo is wholly different than word marks such as THE BEST BEER IN AMERICA and ONCE A MARINE, ALWAYS A MARINE that were refused registration because they were merely informational and did not function as trademarks. *In re Boston Beer Co.*, 53 USPQ2d 1056, 1058-59 (Fed. Cir. 1999); *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1232 (TTAB 2010).

Once again, Benefit is trying to force a square peg into a round hole. Forcing ABH to endure the time and expense of an entire trademark opposition to reach the obvious conclusion that ABH’s Logo is not informational is akin to forcing ABH to endure the time and expense of an entire trademark opposition to prove that its Logo does not consist of or comprise a coat of arms of the United States. It is glaringly apparent from the face of ABH’s Applications that, as a matter of law, a “merely informational” refusal is completely inapplicable to the Applications.

Even if the facts alleged in the notice of opposition are true, Benefit cannot support its legal conclusion that the Logo fails to function as a trademark. Therefore, this claim is futile and should be dismissed.

IV. Conclusion

Through its opposition, Benefit is attempting to rewrite the trademark examining procedures for logos. Logos are not functional. Logos are not informational. And in most cases, logos are not merely descriptive.

Based on the pleadings, ABH is entitled to judgment as a matter of law in this opposition.

Respectfully submitted,
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CERTIFICATE OF ELECTRONIC TRANSMISSION

Date: September 8, 2014

I certify that Anastasia Beverly Hills, Inc.'s Motion for Judgment on the Pleadings is being transmitted electronically to the Trademark Trial and Appeal Board of the United States Patent & Trademark Office, on the date indicated above, through the ESTTA electronic filing system at the web site <http://estta.uspto.gov/>.



Joel R. Feldman, Esq.

CERTIFICATE OF SERVICE

I certify that on September 8, 2014, I served the Anastasia Beverly Hills, Inc.'s Motion for Judgment on the Pleadings by electronic mail only (by agreement) to:

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